

Docket No.: 1460.1045

Serial No. 10/776,254

REMARKS

In accordance with the foregoing, the claims 1, 3, 4, 6, 7, 8, and 9 have been amended to improve form. No new matter is presented in the foregoing amended claims 1, 3, 4, 6, 7, 8, and 9 and, accordingly, approval and entry of same are respectfully requested.

STATUS OF CLAIMS

Claim 5 is cancelled.

Claims 1-4 and 6-9 are pending and under consideration.

ITEM 5: REJECTION OF CLAIMS 1-9 FOR ANTICIPATION UNDER 35 U.S.C. §102(b) OR, IN THE ALTERNATIVE, FOR OBVIOUSNESS UNDER 35 U.S.C. §103(a) OVER THANTRAKUL (U.S. Patent 5,784,611)

The rejection is respectfully traversed. Applicants respectfully submit that amended claim 1 is neither anticipated by nor obvious over Thantrakul, for the following reasons.

In Thantrakul, when one of the memory devices is in the enable state, the other memory device will be in the inhibit state. Further, in Thantrakul, because the on-board flash/eeprom memory 70 cannot always be in the enable state, the state, that the control logic 28 (FIG. 7) is in, changes hectically when data is written onto the on-board flash/eeprom memory 70. The change goes from FIG. 6 to FIG. 10, then to FIG. 11, to FIG. 12, to FIG. 11, and again to FIG. 12 (as shown in FIGS. 9A and 9B).

In contrast to this, in the present claim 1 (as Currently Amended), the external nonvolatile memory, whose program can be rewritten, is always accessible by either the first chip select signal or the second chip select signal, without relying on the operation mode. Thus, the data in the external non-volatile memory can be easily rewritten by mode signals in accordance with the present invention.

ITEM 5, IN PORTION SPANNING PAGES 2-3

In Item 5 at pages 2-3, the Examiner refers to "a potential plurality of addressable internal and/or external volatile and non-volatile memories... [W]here although the terminology utilized by the reference may differ from that claimed, all limitations are considered either obviously inherent in that taught...[sic?].... [Insert added: What is intended by this statement?], clearly obvious to one of ordinary skill in the art... and/or not sufficient to distinguish over prior art.

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These aspects of the rejections of Item 5 are respectfully submitted to be vague and indefinite to the extent of not being understandable and clarification is requested. To the extent these statements rely on contentions of obviousness, they are defective for not identifying specific prior art and/or failing to clarify what additional prior art is being relied upon, in combination with Thantrakul, and for failing to demonstrate *prima facie* obviousness of the undefined combinations of prior art being relied upon.

REJECTION IN ITEM 5 AT PAGE 3 DIRECTED TO DEPENDENT CLAIMS 2-9

This group of rejections, as in the case of the foregoing, is submitted to be indefinite and deficient for failing to identify prior art which purportedly renders the invention "obvious to one of ordinary skill in the art at the time of the claimed invention, and/or not sufficient to patentably distinguish over prior art."

The deficiency of the rejection is abundantly apparent, in that "prior art" is alluded to by the Examiner without identifying same - - much less has any effort whatsoever been made to explain how this non-identified prior art is being relied upon - - and, moreover, is devoid of any demonstration of *prima facie* obviousness of the combination of the unidentified prior art with Thantrakul.

LACK OF *PRIMA FACIE* OBVIOUSNESS OF THE COMBINATIONS OF REFERENCES RELIED UPON

It is submitted that the Action fails to satisfy the requirement of a *prima facie* demonstration of obviousness of the combination and, instead, relies on the discredited bare contention that the combination "would have been obvious to one of ordinary skill in the art...." Moreover, motivation to effect the combinations is not supported by the Examiner's suggestions. See MPEP 706.02(j) which emphasizes that the Examiner should set forth in the Office Action: (A) the relevant teachings of the prior art relied upon, preferably with reference to the relevant column or page number(s) and line number(s) where appropriate, (B) the difference or differences in the claim over the applied reference(s), (C) the proposed modification of the applied reference(s) necessary to arrive at the claimed subject matter, and (D) an explanation why one of ordinary skill in the art at the time the invention was made would have been motivated to make the proposed modification.

To establish a *prima facie* case of obviousness, three basic criteria must be met. First, there must be some suggestion or motivation, either in the references themselves or in the knowledge generally available to one of ordinary skill in the art, to modify the reference or to combine reference teachings. Second, there must be a reasonable expectation of success.

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claim limitations. The teaching or suggestion to make the claimed combination and the reasonable expectation of success must both be found in the prior art and not based on applicant's disclosure. *In re Vaeck*, 947 F.2d 488, 20 USPQ2d 1438 (Fed. Cir. 1991). See MPEP § 2143 - § 2143.03 for decisions pertinent to each of these criteria.

CONCLUSION

There being no further outstanding objections or rejections, it is submitted that the application is in condition for allowance. An early action to that effect is courteously solicited.

Finally, if there are any formal matters remaining after this response, the Examiner is requested to telephone the undersigned to attend to these matters.

If there are any additional fees associated with filing of this Amendment, please charge the same to our Deposit Account No. 19-3935.

Respectfully submitted,

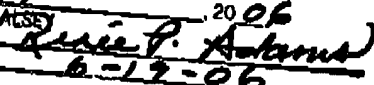
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Date: June 19, 2006By: 

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